REMARKS

Applicant is in receipt of the Office Action mailed September 22, 2004. Claims 1, 23, 26, 29, 32, 35, 42, and 44 have been amended. Thus, claims 1-44 remain pending in the case. Reconsideration of the present case is earnestly requested in light of the following remarks.

Information Disclosure Statement

The Office Action indicated that the previously submitted IDS failed to comply with 37 CFR 1.98(a)(2). However, Applicant notes that since the cited references that were not sent in the IDS were in fact included in an IDS submitted in the parent case, per 37 CFR 1.98(5)(d), copies of the references are not required for the present IDS. Applicant earnestly requests consideration of these references in the determination of patentability of the present case.

Section 102 Rejections

Claims 1-13, 15-21, and 23-44 were rejected under 35 U.S.C. 102(b) as being anticipated by "Compumotor, Motion Builder Start-Up Guide & Tutorial" (henceforth referred to as "Compumotor"). Applicant respectfully disagrees.

As the Examiner is certainly aware, anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). The identical invention must be shown in as complete detail as is contained in the claims. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Moreover, an 'anticipating' reference must describe all of the elements and limitations of the claim in a single reference, and enable one of skill in the field of the invention to make and use the claimed invention. *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1378-79 (Fed. Cir. 2001); *Richardson v. Suzuki Motor Co.*,

868 F.2d 1226 (Fed. Cir. 1989)." *In re Merck & Co., Inc. v. Teva Pharm. USA, Inc.,* 347 F.3d 1367, 1372 (Fed. Cir. 2003).

Amended Claim 1 recites:

1. A computer-implemented method for creating a motion control sequence, the method comprising:

displaying a graphical user interface (GUI) that provides GUI access to a set of motion control operations;

receiving user input to the graphical user interface specifying the sequence of motion control operations;

automatically generating a program implementing the specified sequence of motion control operations; and

performing the specified sequence of motion control operations.

The Office Action asserts that Compumotor teaches all the limitations of amended claim 1. Applicant respectfully submits that claim 1 includes features and limitations not disclosed by Compumotor.

For example, nowhere does Compumotor teach or suggest *automatically generating a program implementing the specified sequence of motion control operations.* Rather, as Compumotor discloses in the cited portions and elsewhere, in the system of Compumotor, the user manually creates an iconic or graphical program or diagram by dragging and dropping icons representing respective functions, and manually linking the icons to specify the relationships between the icons. In other words, the user manually creates what may be considered "graphical source code" for a motion control graphical program. The user/developer then "builds" the program/project to produce executable machine code (specifically, 6000 machine code) for the manually created graphical program. In other words, in Compumotor, the user both *manually* creates the graphical program, and *manually* invokes a build process to generate an executable version. For example, as Compumotor describes in pages 74-87, the user manually drags and drops function icons and other graphical program elements onto a diagram, then manually links

13

the icons together to form a graphical program. Applicant notes that the manual creation of graphical programs as disclosed by Compumotor is described in detail in U.S. Patent No. 5,481,741 titled "Method and Apparatus for Providing Attribute Nodes in a Graphical Data Flow Environment", filed September 22, 1993, which is commonly assigned (with the present Application) to National Instruments Corporation.

In direct contrast, in Applicant's invention, a program, either graphical or text-based, is *automatically* generated based on the specified sequence, where the generated program is executable to perform the specified sequence of motion control operations. In other words, once the user has specified the motion control sequence, e.g., a graphical or text-based program is *automatically generated* implementing the specified sequence.

Thus, Applicant respectfully submits that Compumotor fails to teach or describe this limitation of claim 1, and so for at least the reasons provided above, claim 1 and those claims dependent therefrom are patentably distinct and non-obvious over Compumotor, and are thus allowable.

Amended independent claims 29, 32, 35, 42, and 44 include similar limitations as amended claim 1, and so the above arguments apply with equal force to these claims. Thus, for at least the reasons provided above, claims 29, 32, 35, 42, and 44, and those claims respectively dependent therefrom, are patentably distinct and non-obvious over Compumotor, and are thus allowable.

Removal of the 102 rejection of claims 1-13, 15-21, and 23-44 is respectfully requested.

Section 103 Rejections

Claims 14 and 22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Compumotor. Applicant respectfully disagrees.

As noted above, the independent claims have been amended to overcome rejections under 35 U.S.C. 102. Applicant respectfully submits that the amended independent claims are nonobvious and allowable, as argued above. Applicant respectfully submits: "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine* , 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)" as stated in the MPEP §2143.03. With this in mind, Applicant

14

respectfully submits that claims 14 and 22, dependent from claim 1, are non-obvious and thus allowable.

Also, as the Examiner knows, to establish a prima facie obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP 2143.03. Obviousness cannot be established by combining or modifying the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so. In re Bond, 910 F. 2d 81, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990).

Moreover, as held by the U.S. Court of Appeals for the Federal Circuit in Ecolochem Inc. v. Southern California Edison Co., an obviousness claim that lacks evidence of a suggestion or motivation for one of skill in the art to combine prior art references to produce the claimed invention is defective as hindsight analysis.

In addition, the showing of a suggestion, teaching, or motivation to combine prior teachings "must be clear and particular . . .. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'." *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination.

Applicant respectfully submits that the only motivations the Examiner has provided for adding the features and limitations of claims 14 and 22 to the admitted (by the Examiner) deficient art of Compumotor are "to provide a user interface with user satisfaction and to avoid redundant steps" (claim 14); and "to give a clearer and more comprehensive view of the data that is to be displayed." (claim 22). In other words, the Examiner has simply cited *improved results* as motivation, using claims 14 and 22 as blueprints, which is clearly hindsight analysis, and is thus improper. Additionally, the Examiner has failed to disclose any source of the additional limitations. Applicant thus submits that claim 14 and 22 are both non-obvious and patentable over Compumotor. Removal of the 103 rejection of claims 14 and 22 is respectfully requested.

Applicant also asserts that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the independent claims have been shown to be patentably distinct, a further discussion of the dependent claims is not necessary at this time.
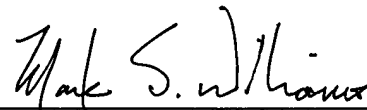
CONCLUSION

Applicant submits the application is in condition for allowance, and an early notice to that effect is requested.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 50-1505/5150-54200/JCH.

Also enclosed herewith are the following items:

☒ Return Receipt Postcard

Respectfully submitted,

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17